

## **REMARKS**

Applicants respectfully request entry of the above amendments and reconsideration of the following arguments pursuant to 37 C.F.R. § 1.111.

### **1. Status of the Claims**

Claims 1-9 and 11-20 stand pending and rejected. Claims 10 and 21-23 stands previously canceled.

Upon entry of the amendments, Applicants amend claims 3-9, 11, 14, and 16-20 to more precisely recited the claimed subject. Claims 2, 12-13, and 15 stand canceled. Support for the amendments can be found at least, for example, from the originally filed claims. For example, claim 14 is amended to make it dependent form claim 11. Applicants do not believe that the amendments add prohibited subject matter that is unsupported in the Specification as filed.

The claims have been amended without prejudice to, or disclaimer of, the cancelled subject matter. Applicants reserve the right to file a continuation or divisional application on any subject matter canceled by way of amendments.

### **2. Information Disclosure Statement (IDS)**

In the Office Action mailed April 28, 2009, the Office lined through the reference, Ryoza **Sotoike**, "Sake no Jiten," Kabushiki Kaisha Tokoydo Shuppan, June 25, 1975, page 124 ("Sotoike"). The Office alleged that Sotoike has not been received and therefore could not be considered. The Office reminds Applicants again in the present Office Action to correct the deficiency. Office Action, page 2. Applicants note that the Office must have meant that an English translation is required for the Office to consider this reference, because Sotoike (Japanese) was in fact submitted May 25, 2007, with an Information Disclosure Statement.

Sotoike is cited as an "A" reference in the International Search Report (ISR) for the international application PCT/JP2004/018460, from which the present application claims priority. An English translation of the ISR was submitted May 25, 2007, with an IDS. According to M.P.E.P. § 609.04(a), if a non-English reference was cited in a search report in a corresponding international application, *submission of an English language version of the relevant portion of the search report shall suffice the Applicants' disclosure duty.*

Accordingly, English translation is **not** required for Sotoike reference. The Office is respectfully requested to consider and acknowledge consideration of the reference based on the ISR.

Applicants hereby submit a verified English translation of **Hoppy de Happy-to**, *Hoppy de Happy Dokuhon*, Kabushiki Kaisha Asupekuto, August 22, 2000, pp. 30-35 (“Hoppy de Happy-to”) (enclosed as **Appendix I**). As a courtesy, Applicants further provide the PTO form 1449 citing Hoppy de Happy-to in Appendix I (the PTO form 1449 was previously submitted May 25, 2007). No fee is believed to be necessary, because the reference was already listed on an IDS.

### 3. **Withdrawn Objections and Rejections**

Applicants appreciate the Office’s withdrawal of the following objections and rejections:

- 1) the objection to claim 13 for reciting “otsurui shochu”;
- 2) the rejection of claims 1-23 under 35 U.S.C. § 112, second paragraph;<sup>1</sup>
- 3) the rejection of claims 1-10, 16, and 23 under 35 U.S.C. § 102(b) over **Kitajima et al.**, *Beer no Hanashi*, Gihodo Shuppan Co., Ltd., April 5, 1994, pp. 169-170 (“Kitajima”) as evidenced by **Oono** (U.S. Published Application No. 2005/022095) (“Oono”);
- 4) the rejection of claims 1-6, 9-15, and 21-23 under 35 U.S.C. § 102(b) over **Hoppy de Happy-to** as evidenced by **Oono** and **Japanese Spirits** (*available at* <http://jal.com/it/shochu/whats/jshochu.html>) (“Japanese Spirits”);
- 5) the rejection of claims 5, 11, 14, and 16-18 under 35 U.S.C. § 103(a) over **Kitajima** or **Hoppy de Happy-to** as evidenced by **Brewing Techniques: Wheat Beer** (*available at* [http://www.brewingtechniques.com/library/styles/1\\_1style.html](http://www.brewingtechniques.com/library/styles/1_1style.html)) (“Brewing Techniques”); and
- 6) the rejection of claims 19-22 under 35 U.S.C. § 103(a) over **Kitajima** in view of **Hoppy de Happy-to**.

Office Action, pages 2-3.

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<sup>1</sup> The Office states: “The 35 USC 112 rejections of claims 1, 2, 9, and 23 made of record in the office action mailed on 28 April 2009 are withdrawn due to applicant’s amendment, filed on 28 July 2009.” Office Action, page 2 (emphasis added). The Office is reminded that all claims 1-23 were subject to indefiniteness rejection in the Office Action mailed April 28, 2009. Claims 3-22 were rejected due to their dependency from claims 1-2. The Office must have meant that the indefiniteness rejection to claims 1-23 has been withdrawn. For the clarity of the record, the Office is requested to clarify the issue within its next communication.

**4. Rejection of the Claims Under 35 U.S.C. § 112, Second Paragraph**

The Office rejects claims 4-5 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. The Office alleges that the recitation of “other starting materials” is unclear. *Id.*, at 3.

Without acquiescing as to the merits of the rejection, Applicants amend claims 4-5 to no longer cite “other starting materials.” Claim 4 as amended recites that starting materials may comprising malt, hop, and water; while claim 5 as amended recites that the starting materials may further comprise listed material(s). The indefiniteness rejection is thus moot. Applicants respectfully request withdrawal of the rejection and allowance of the claims.

**5. Rejection of the Claims Under 35 U.S.C. § 102(b)**

The Office rejects claims 1-6, 9, 12, 15, and 19-20 under 35 U.S.C. § 102(b) as allegedly anticipated over **Carbomb** from the Webtender (“Carbomb”), as evidenced by **Guinness** from the Greens Beverages (“Guinness”), **Jameson’s Irish Whiskey** from the Drinkmixer (“Jameson’s Whiskey”); **Guinness Stout** from the Drinkmixer (“Guinness Stout”), and **Bailey’s Irish Cream** from the Drinkmixer (“Bailey’s Irish Cream”).

**5.1. Claims 1-2 and 9**

Carbomb allegedly teaches a malt fermented beverage comprising Guinness Stout and Jameson’s Whiskey, which allegedly read on the claimed component A and component B, respectively. Office Action, page 4. Guinness Stout (4.1% alcohol content) is allegedly an alcohol-containing material made of fermented barley. Jameson’s Whiskey (40% alcohol content) is allegedly an alcohol-containing distillate made from barley. *Id.*

Claim 1 recites “a ratio between an alcohol content from the alcohol-containing material of the component A and an alcohol content from the alcohol-containing distillate of the component B” (alcohol content ratio) in the range of about 97.5:2.5 to about 90:10. The Office asserts that Carbomb discloses the claimed alcohol content ratio, because a ratio of the alcohol content of components is 9.75:1 (as Whiskey:Beer = 40%/4.1%). *Id.*

Applicants traverse. Prior art that anticipates a claim must disclose each and every element of the claim explicitly or inherently. See *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993).

The Office's rejection is unsupported. Carbomb fails to disclose each and every element of claim 1, because the Office incorrectly calculated Carbomb's alcohol content ratio regarding Guinness and Whiskey. The Office is reminded that the claimed alcohol content ratio is calculated based on the alcohol content from each component. The Office's calculation is directly based on the alcohol content of each component. The Office's calculation fails to take into account the volume factor. Additionally, the Office switches the numerator and denominator in the calculation. The claimed alcohol content ratio should be calculated as following:

$$C_A V_A : C_B V_B$$

wherein  $C$  represents the alcohol content of a component, and  $V$  represents the volume of the component.

See e.g., page 13, Example 1 and Table 1 of the Specification. Based on the above formula, Carbomb would give an alcohol content ratio (Guinness:Whiskey) of about 57.1:42.9 to about 58.9:41.1.<sup>2</sup> This range is outside the claimed range of claim 1. As the cited references fail to disclose at least the claimed ratio element, claim 1 is novel.

As to claim 2, Office asserts that Carbomb discloses a volume ratio of 13:1 for Guinness to Jameson's Whiskey. Office Action, page 4. This volume ratio is allegedly within the claimed range of claim 2. *Id.* Upon entry of the present amendments, claim 2 stands canceled, mooting the rejection.

Applicants further traverse the rejection of claim 9. Claim 9 depends directly from claim 1, and thus incorporates its limitations. The cited art fails to disclose at least the ratio element recited in claim 1 for the reasons above. Likewise, claim 9 must also be novel.

## 5.2. Claims 3-6

Guinness allegedly discloses that Guinness is a beer made from malt, barley, hops, and water. *Id.* The Office apparently alleges that Guinness reads upon the component A and the starting materials recited in claims 3-6.

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<sup>2</sup> Alcohol content ratio calculation:  $4.1\% \times 13 \text{ oz} : 40\% \times 1 \text{ oz} = 57.1:42.9$ , and  $4.1\% \times 14 \text{ oz} : 40\% \times 1 \text{ oz} = 58.9:41.1$ .

Applicants traverse. Each of claims 3-6 incorporates all elements from claim 1 because of its dependency. As discussed in section 5.1 *supra*, claim 1 is novel because the cited art fails to disclose at least the claimed ratio element. Claims 3-6 are likewise novel over the cited art.

5.3. Claims 12 and 15

The Office alleges that the limitations in claims 12 and 15 do not determine the patentability of the product. *Id.*, at 4-5.

Without acquiescing as to the merits of the rejection, claims 12 and 15 stand canceled, mooted the rejection.

5.4. Claim 19

Jameson's Whiskey allegedly has an alcohol content of 40%. *Id.*, at 5. The Office argues that Jameson's Whiskey's alcohol content reads on the alcohol content recited in claim 19.

Applicants traverse. Claim 19 depends from claim 1, thus incorporating its limitations. As discussed in section 5.1 *supra*, claim 1 is novel because the cited art fails to disclose at least the claimed ratio element. Claim 19 is likewise novel over the cited art.

5.5. Claim 20

Carbomb allegedly has an alcohol content of about 7.353%. *Id.*, at 5. The Office argues that Carbomb's alcohol content reads on the alcohol content recited in claim 20.

Applicants traverse. Claim 20 incorporates all elements from claim 1. As discussed in section 5.1 *supra*, claim 1 is novel, because the cited art fails to disclose at least the claimed ratio element. Claim 20 is likewise novel over the cited art.

In view of the above arguments, claim 1 is novel, because the cited art fails to disclose at least the claimed ratio element. Claims 3-6, 9, and 19-20 are likewise novel over the cited art because of their dependency from claim 1. The rejection of claims 2, 12, and 15 is moot because of their cancellation. Applicants respectfully request withdrawal of the rejection and allowance of the claims.

**6. Rejection of the Claims under 35 U.S.C. § 103(a)**

**6.1. Rejection of Claims 1-6, 9, 11-16, and 19-20**

The Office rejects claims 1-6, 9, 11-16, and 19-20 under 35 U.S.C. § 103(a) as allegedly obvious over **Hoppy de Happy-to** in view of either **Shinozaki** (JP 60241883) (“Shinozaki”) or **Japan Alcoholic Beverages** from the Global Gourmet (“Japan Alcoholic Beverages”), as evidenced by **Japan - Taxes on Alcoholic Beverage** from the World Trade Organization (“Japan – Taxes”).

**6.1.1. Claims 1-2, 9 and 19**

Hoppy de Happy-to allegedly teaches a malt fermented beverage comprising Hoppy and shochu. Office Action, page 5. The Office alleges that (1) Hoppy reads on the claimed component A as an alcohol-containing material made of barley; and (2) shochu reads on the claimed component B as distillate. *Id.* The Office argues that the shochu in Hoppy de Happy-to has an alcohol content of 25%. *Id.*

Claim 1 recites “a ratio between an alcohol content from the alcohol-containing material of the component A and an alcohol content from the alcohol-containing distillate of the component B” (“alcohol content ratio) in the range of about 97.5:2.5 to about 90:10. The Office argues that the mixed beverage in Hoppy de Happy-to teaches the claimed alcohol content ratio, because a ratio of the alcohol content of components is 31.25:1 (shochu : Hoppy = 25%/0.8%). *Id.*, at 6.

Applicants traverse. “[O]bviousness requires a suggestion of *all* limitations in a claim.” *CFMT, Inc. v. Yieldup Int’l Corp.*, 349 F.3d 1333, 1342, 68 U.S.P.Q.2d 1940, 1947 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974) (emphasis added). Furthermore, one common inquiry in the above tests of obviousness is whether a skilled artisan would have had reasonable expectation of success to practice the claimed invention. *Examination Guidelines for Determining Obviousness under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57,528.

The Office’s rejection is unsupported by the references when viewed alone or in combination. The cited art fails to teach or suggested the claimed alcohol content ratio. The Office’s calculation of the alcohol content ratio is incorrect. *See* section 5.1 *supra*. According to

the formula in section 5.1 *supra*, the mixed beverage of Hoppy de Happy-to would give an alcohol content ratio (Hoppy:shochu) of about 7.0:93.0 to about 24.2:75.8.<sup>3</sup> This range is outside the claimed range of claim 1. The cited art thus fails to teach or suggest at least the claimed alcohol content ratio. No change in ratio or instruction is provided of teaching a combination that would achieve the desired taste of the presently claimed product. Without all claim elements taught, there further cannot be expectation to make or use the claimed product. Accordingly, claim 1 is nonobvious over cited references.

As to claim 2, Office asserts that Hoppy de Happy-to teaches a volume ratio of 10:1 (Hoppy:shochu). Office Action, page 6. This volume ratio is asserted by the Office to be within the claimed range of claim 2. *Id.* Upon entry of the present amendments, claim 2 stands canceled, mooted rejection.

Claim 19 recites an alcohol content of 25 to 45% for the component. The Office apparently rejects claim 19, because the alcohol content of shochu allegedly overlaps with the claimed range.

Applicants traverse. Claim 19 recites all the limitations of claim 1, because it depends directly from claim 1. Claim 1 is nonobvious, because the cited art fails to teach or suggest all the claimed limitations. Claim 19 is likewise nonobvious over the cited art.

Furthermore, Applicants have discovered for the *first time* that mixing component A and component B with the recited ratio results in a beverage with refreshing finish, *i.e.*, crisp taste while ensuring robust feel. *See* page 2, line 22 through page 3, line 3, page 12, lines 9-17, and page 13, Table 1 of the Specification. At best, Hoppy de Happy-to teaches a “soothing feeling” for the mixture of Hoppy and shochu. *See* last paragraph on page 3 of Hoppy de Happy-to. The “soothing feeling” is neither crisp taste nor robust feel. There is no suggestion in any of the references of how to achieve either a crisp taste or robust feel. Therefore, there is no guidance, let alone expectation of success, to alter the ratio in order to achieve this result. The claimed beverage thus possesses *unexpected*, advantageous properties.

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<sup>3</sup> For the mixed beverage with an alcohol content of 3%, the volume ratio would be 90.9:9.1 (Hoppy : shochu), because  $90.9\% \times 0.8\% + 9.1\% \times 25\% = 3\%$ . The corresponding alcohol content ratio would be  $(90.9\% \times 0.8\%) : (9.1\% \times 25\%) = 21.7:78.3$  (Hoppy : shochu). For the mixed beverage with an alcohol content of 8%, the

#### 6.1.2. Claims 11-16

The Office admits that Hoppy de Happy-to does not teach that the alcohol-containing distillate (shochu) is made from wheat. Office Action, page 6. Either Shinozaki or Japan Alcoholic Beverages is relied upon for allegedly teaching that shochu is made from wheat. *Id.* The Office asserts that a skilled artisan would have considered it obvious to select a wheat-based shochu. *Id.*, at 6-7. The Office further asserts that the limitations in claims 12-13 and 15 reciting the production of shochu do not determine the patentability of the product. *Id.*, at 7.

Applicants traverse. Each of claims 11, 14, and 16 incorporate all elements from claim 1, because of they depend directly or indirectly from claim 1. As discussed in section 6.1.1 *supra*, claim 1 is nonobvious, because the cited art fails to teach or suggest at least the claimed ratio element. The cited art likewise fails to teach or suggest all elements of each of claims 11, 14, and 16. Without all claim elements taught, there cannot be expectation to make or use the claimed product. Furthermore, the claimed beverage possesses *unexpected*, advantageous properties over the cited art, *i.e.*, its crisp taste while ensuring robust feel. *See* section 6.1.1 *supra*. There is no suggestion in any of the references of how to achieve either a crisp taste or robust feel. Therefore, there is no guidance, let alone expectation of success, to alter the ratio in order to achieve this result. Accordingly, claims 11, 14, and 16 are nonobvious over the cited art. Upon entry of the present amendments, claims 12-13 and 15 stand canceled, mooted the rejection.

#### 6.1.3. Claims 3-5

The starting materials for Hoppy allegedly include malt, starch, and hops. Office Action, page 7. The Office asserts that inclusion of water in making Hoppy is implied. *Id.* The Office apparently argues that the starting materials for Hoppy overlap with the claimed starting materials for component A.

Applicants traverse. Each of claims 3-5 incorporates all elements from claim 1 because of its dependency from claim 1. As discussed in section 6.1.1 *supra*, claim 1 is nonobvious,

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volume ratio would be 90.9:9.1 (Hoppy : shochu), because  $70.2\% \times 0.8\% + 29.8\% \times 25\% = 8\%$ . The



because the cited art fails to teach or suggest at least the claimed ratio element. The cited art likewise fails to teach or suggest all elements of each of claims 3-5. Without all claim elements taught, there cannot be expectation to make or use the claimed product. Furthermore, the claimed beverage possesses *unexpected*, advantageous properties over the cited art, *i.e.*, its crisp taste while ensuring robust feel. *See* section 6.1.1 *supra*. There is no suggestion in any of the references of how to achieve either a crisp taste or robust feel. Therefore, there is no guidance, let alone expectation of success, to alter the ratio in order to achieve this result. Accordingly, claims 3-5 are nonobvious over the cited art.

#### 6.1.4. Claim 6

Hoppy de Happy-to allegedly teaches a component that is beer. Office Action, page 7. Claim 6 recites that the component A may be a beer or a low-malt beer.

Applicants traverse. Claim 6 depends directly from claim 1. Therefore claim 6 recites all the limitations of claim 1. As discussed in section 6.1.1 *supra*, claim 1 is nonobvious, because the cited references fail to teach or suggest at least the claimed ratio element. The cited art likewise fails to teach or suggest all elements of claim 6. Without all claim elements taught, there cannot be expectation to make or use the claimed product. Furthermore, the claimed beverage possesses *unexpected*, advantageous properties over the cited art, *i.e.*, its crisp taste while ensuring robust feel. *See* section 6.1.1 *supra*. There is no suggestion in any of the references of how to achieve either a crisp taste or robust feel. Therefore, there is no guidance, let alone expectation of success, to alter the ratio in order to achieve this result. Accordingly, claim 6 is nonobvious over the cited art.

#### 6.1.5. Claim 20

Hoppy de Happy-to allegedly teaches a mixed beverage with an alcohol content of 3-8%. Office Action, page 7. Claim 20 recites an alcohol content of 1 to 15%.

Applicants traverse. Claim 20 incorporates all elements from claim 1 because of its dependency from claim 1. As discussed in section 6.1.1 *supra*, claim 1 is nonobvious, because

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corresponding alcohol content ratio would be  $(70.2\% \times 0.8\%):(29.8\% \times 25\%) = 7.0:93.0$  (Hoppy : shochu).

the cited art fails to teach or suggest at least the claimed ratio element. The cited references likewise fail to teach or suggest all elements of claim 20. Without all claim elements taught, there cannot be expectation to make or use the claimed product. Furthermore, the claimed beverage possesses *unexpected*, advantageous properties over the cited art, *i.e.*, its crisp taste while ensuring robust feel. *See* section 6.1.1 *supra*. There is no suggestion in any of the references of how to achieve either a crisp taste or robust feel. Therefore, there is no guidance, let alone expectation of success, to alter the ratio in order to achieve this result. Accordingly, claim 20 is nonobvious over the cited art.

In view of the above arguments, claims 1, 2-6, 9, 11, 14, 16, and 19-20 are nonobvious, because cited references fail to teach at least the claimed ratio element. Claims 2, 12-13, and 15 stand canceled, mooted the rejection. Applicants respectfully request withdrawal of the rejection and allowance of the claims.

#### 6.2. Rejection of Claims 7-8

The Office rejects claims 7-8 under 35 U.S.C. § 103(a) as allegedly obvious over unpatentable over **Carbomb**, as evidenced by **Guinness**, **Jameson's Whiskey**, **Guinness Stout**, and **Bailey's Irish Cream**, as applied to claims 1-6, 12, 15, and 19-20 above, and further in view of **Tripp et al.** (U.S. Patent No. 5,618,572) ("Tripp").

The Office admits that Carbomb does not teach the malt proportion of the component A, which allegedly reads on Guinness. Office Action, page 8. Tripp is relied upon for allegedly teaching that (1) malt proportion may range from 26 to 127% (malt/dextrose), and (2) a 80-100% pale malt beer may be used as a feed beer. *Id.* Claims 7-8 recite that the component A has a malt proportion of at least 20% and at least 40%, respectively. The Office asserts that a skilled artisan would have been motivated to change the malt proportion to obtain a final product with acceptable drinkability and taste. *Id.*, at 8-9. No reasoning as to why an artisan would have been motivated to alter these ratios and percentages is provided. Additionally, there is no suggestion in any of the references of how to achieve either a crisp taste or robust feel. Therefore, there is no guidance, let alone expectation of success, to alter the ratio in order to achieve this result.

Applicants traverse. As discussed in section 5.1 *supra*, Carbomb (together with Guinness, Jameson's Whiskey, Guinness Stout, and Bailey's Irish Cream) fail to teach at least the claimed ratio element of claim 1. Tripp fails to teach the claimed ratio element, and therefore Tripp fails to cure the defects of the other references. The cited references, alone or viewed in combination, thus fail to teach at least the claimed ratio element in claim 1. Each of claims 7-8 incorporates all elements from claim 1 because of its dependency. The cited art likewise fails to teach or suggest all elements of claims 7-8. Without all claim elements taught, there cannot be expectation to make or use the claimed product.

Furthermore, Applicants have discovered for the *first time* that mixing component A and component B with the recited ratios results in a beverage with refreshing finish, *i.e.*, crisp taste while ensuring robust feel. *See* page 2, line 22 through page 3, line 3, page 12, lines 9-17, and page 13, Table 1 of the Specification. Cited references fail to address the taste of alcohol-containing beverages. The claimed beverage thus possesses *unexpected*, advantageous properties over the cited art. There is no suggestion in any of the references of how to achieve either a crisp taste or robust feel. Therefore, there is no guidance, let alone expectation of success, to alter the components in order to achieve this result.

Accordingly, claims 7-8 are nonobvious over the cited art. Applicants respectfully request withdrawal of the rejection and allowance of the claims.

### 6.3. Rejection of Claims 7-8 and 17-18

The Office rejects claims 7-8 and 17-18 under 35 U.S.C. § 103(a) as allegedly obvious over **Hoppy de Happy-to** in view of either **Shinozaki** or **Japan Alcoholic Beverages**, as evidenced by **Japan – Taxes**, as applied to claims 1-6, 9, 11-16, 19-20 above, and further in view of **Tripp**.

#### 6.3.1. Claims 7-8

The Office admits that Hoppy de Happy-to in view of either Shinozaki or Japan Alcoholic Beverages does not teach the malt content of component A (allegedly Hoppy). Office Action, page 9. Tripp is relied upon for allegedly teaching that (1) malt proportion may range from 26 to 127% (malt/dextrose), and (2) a 80-100% pale malt beer may be used as a feed beer.

*Id.* Claims 7-8 recite that the component A has a malt proportion of at least 20% and at least 40%, respectively. The Office asserts that a skilled artisan would have been motivated to change the malt proportion to obtain a final product with acceptable drinkability and taste. *Id.*

Applicants traverse the rejection of claims 7-8. As discussed in section 6.1.1 *supra*, Hoppy de Happy-to, Shinozaki, Japan Alcoholic Beverages, and Japan – Taxes fail to teach at least the claimed ratio element of claim 1. Tripp fails to teach the claimed ratio element, and therefore Tripp fails to cure the defects of the other references. The cited references, when viewed alone or in combination, fail to teach at least the claimed ratio element of claim 1. Each of claims 7-8 incorporates all elements from claim 1 because of its dependency. Cited art likewise fails to teach or suggest all elements of claims 7-8. Without all claim elements taught, there cannot be expectation to make or use the claimed product.

Furthermore, Applicants have discovered for the *first time* that mixing component A and component B with the recited ratios results in a beverage with refreshing finish, *i.e.*, crisp taste while ensuring robust feel. *See* page 2, line 22 through page 3, line 3, page 12, lines 9-17, and page 13, Table 1 of the Specification. At best, Hoppy de Happy-to teaches a “soothing feeling” for the mixture of Hoppy and shochu. *See* last paragraph on page 3 of Hoppy de Happy-to. The “soothing feeling” is neither crisp taste nor robust feel. The other references fail to address the taste of alcohol-containing beverages and how to achieve either a crisp taste and/or robust feel. The claimed beverage thus possesses *unexpected*, advantageous properties. *See* section 6.1.1 *supra*. Therefore, there is no guidance, let alone expectation of success, to alter the components in order to achieve this result. Accordingly, claims 7-8 is nonobvious over the cited art.

### 6.3.2. Claim 18

Both Shinozaki and Japan Alcoholic Beverages allegedly teach that shochu is made from wheat. Office Action, page 10. Claim 18 recites, *inter alia*, that (1) the component A has a malt proportion of 40-60%, and (2) the component B is a wheat spirit.

Applicants traverse. As discussed in section 6.1.1 *supra*, Hoppy de Happy-to, Shinozaki, Japan Alcoholic Beverages, and Japan – Taxes fail to teach at least the claimed ratio element of claim 1. Tripp fails to teach the claimed ratio element. Thus, it cannot cure the defects. The cited references, when viewed alone or in combination, fail to teach at least the claimed ratio

element of claim 1. Claim 18 incorporates all elements from claim 1, because it depends directly from claim 1. The cited art must fail to teach or suggest all elements of claim 18. Without all claim elements taught, there cannot be expectation to make or use the claimed product.

Furthermore, Applicants have discovered for the *first time* that mixing component A and component B with the recited ratios results in a beverage with refreshing finish, *i.e.*, crisp taste while ensuring robust feel. *See* page 2, line 22 through page 3, line 3, page 12, lines 9-17, and page 13, Table 1 of the Specification. At best, Hoppy de Happy-to teaches a “soothing feeling” for the mixture of Hoppy and shochu. *See* last paragraph on page 3 of Hoppy de Happy-to. The “soothing feeling” is neither crisp taste nor robust feel. The other references fail to address the taste of alcohol-containing beverages, let alone how to achieve crisp taste and/or a robust feel. Therefore, there is no guidance, let alone expectation of success, to alter the components in order to achieve this result. The claimed beverage thus possesses *unexpected*, advantageous properties. *See* section 6.1.1 *supra*. Accordingly, claim 18 is nonobvious over the cited art.

#### 6.3.3. Claim 17

The Office argues that the limitation “the distillate of alcohol-containing material of the component B is otsu-rui mugi shochu” of claim 17 does not determine the patentability of the product. Office Action, page 10.

Applicants traverse. First, the Office incorrectly interprets claim 17. Claim 17 depends directly upon claim 1. Claim 1 recites component B as “an alcohol-containing distillate obtained by distilling and alcohol-containing material at least partly made of wheat or barley.” Claim 17 recites, *inter alia*, that the component B is a type of shochu. This is *not* a method limitation. Regardless of the methods of production used for the claimed shochu, the recitation of shochu as the component B does contribute to the patentability of claim 17.

Second, the cited references fail to teach or suggest all claim elements. As discussed in section 6.1.1 *supra*, Hoppy de Happy-to, Shinozaki, Japan Alcoholic Beverages, and Japan – Taxes fail to teach at least the claimed ratio element of claim 1. Tripp fails to cure the defects of these references. Thus, the cited references, alone or viewed in combination, fail to teach at least the claimed ratio element in claim 1. Claim 17 incorporates all elements from claim 1 because of

its dependency. The cited art likewise fails to teach or suggest all elements of claim 17. Without all claim elements taught, there cannot be expectation to make or use the claimed product.

Furthermore, Applicants have discovered for the *first time* that mixing component A and component B with the recited ratios results in a beverage with refreshing finish, *i.e.*, crisp taste while ensuring robust feel. *See* page 2, line 22 through page 3, line 3, page 12, lines 9-17, and page 13, Table 1 of the Specification. At best, Hoppy de Happy-to teaches a “soothing feeling” for the mixture of Hoppy and shochu. *See* last paragraph on page 3 of Hoppy de Happy-to. However, the reference teaches nothing with respect to how to achieve a crisp taste and robust feel. A “soothing feeling” is neither crisp taste nor robust feel. The other references fail to address these taste aspects or provide guidance on how to achieve them. The claimed beverage thus possesses *unexpected*, advantageous properties. *See* section 6.1.1 *supra*. Therefore, there is no guidance, let alone expectation of success, to alter the ratio in order to achieve this result. Accordingly, claim 17 is nonobvious over the cited art.

In view of the above arguments, claims 7-8 and 17-18 are nonobvious, because cited references fail to teach at least the claimed ratio element. Applicants respectfully request withdrawal of the rejection and allowance of the claims.

**CONCLUSION**

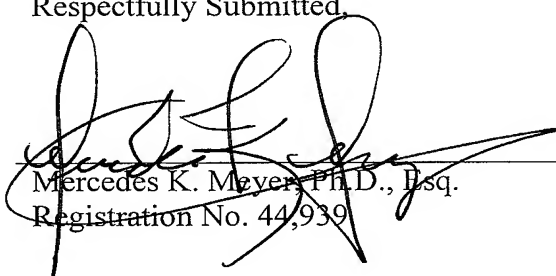
Should the Office have any questions or comments regarding Applicants' amendments or response, please contact Applicants' undersigned representative at (202) 842-8821. Furthermore, please direct all correspondence to the below-listed address.

In the event that the Office believes that there are fees outstanding in the above-referenced matter and for purposes of maintaining pendency of the application, the Office is authorized to charge the outstanding fees to Deposit Account No. 50-0573. The Office is likewise authorized to credit any overpayment to the same Deposit Account Number.

Respectfully Submitted,

Date: February 24, 2010

By: \_\_\_\_\_

  
Mercedes K. Meyer, Ph.D., Esq.  
Registration No. 44,939

DRINKER BIDDLE & REATH LLP  
Customer No. **55694**  
1500 K Street, N.W., Suite 1100  
Washington, D.C. 20005-1209  
Tel. No.: (202) 842-8800  
Fax No.: (202) 842-8465

## **APPENDIX I**

Verified translation of Hoppy de Happy-to

and

Courtesy copy of PTO form 1449



# DECLARATION

In the matter of an application for Letter Patent by SUNTORY HOLDINGS LIMITED,

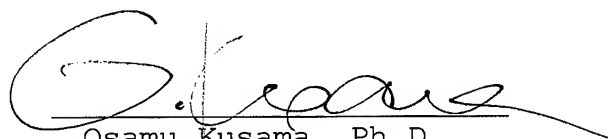
I, Osamu KUSAMA, Patent Attorney, whose full post office address is 7th Floor, Iwata Bldg., 5-12, Iidabashi 4-chome, Chiyoda-ku, Tokyo 102-0072, Japan, do solemnly and sincerely declare as follows:

1. I am well acquainted with Japanese and English language.
2. The following is the true translation into English language of "Hoppy College Magazine Course", i.e., Hoppy de Happy-to.

And I am this solemn declaration conscientiously believing the same to be true.

Declared at Tokyo, Japan

This            day of February 3, 2010.



Osamu Kusama, Ph.D.  
(Translator)

1/5

## スポーツになる？

[illegible]

~~それは「三冷主義」。ホッパ、  
機前、ジミシをすべて冷やし  
ておくことが大切なのです。氷  
を入れてはいけません。~~

アルコール度が分  
かる便利な星です。  
25度の焼酎をこ  
まで入れるとアル  
コール度が8%

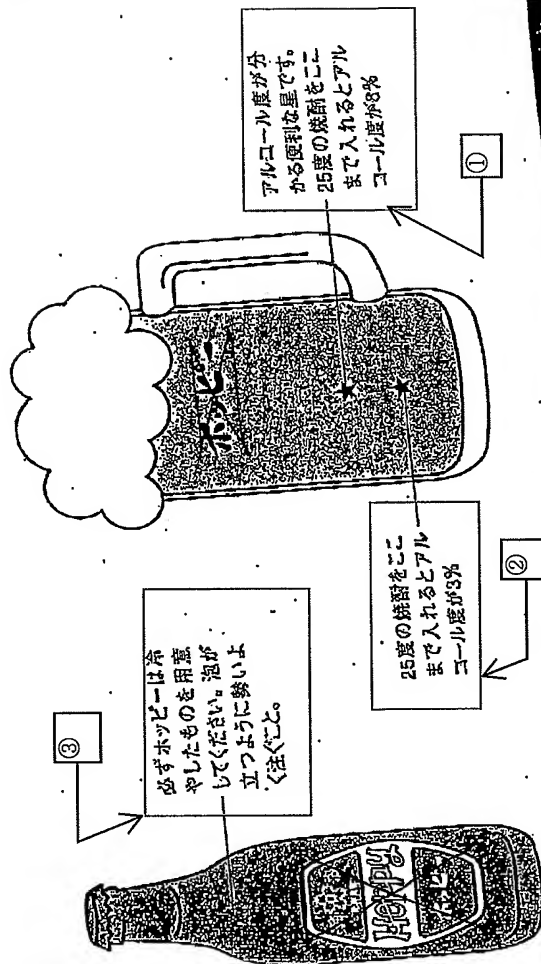
ホッパとーなになに？

では作法です。ジヨツキに焼酎を入れます。ジヨツキの星でアルコール度を調整しましょう。下の星まで25度の焼酎を入れるとアルコール度は約3%になります。お好みの度数で楽しんでください。

次はホッケーのつき方にまい  
ります。焼酎とホッケーがよく  
混ざるように勢いよく注ぎま  
しょう。そのほうが淹れもよく立  
ちます。

偶れば、焼酎の量に合わせ  
て瓶の中のホッピーを余らせる  
ことなく注ぐことができるは  
ずです。くれぐれもマドラーや  
割り箸でかき混ぜないでくだ  
さい。焼酎は味のない甲類の焼  
酎で楽しんでください。

これがホッピーのおいしい飲み方なのです。当然のように氷を入れて出す店が多いけど。



アルコール度が分  
かる便利な星です。  
25度の焼酎をここ  
まで入れるとアル  
コール度が8%

25度の焼酎をこ  
まで入れるとアル  
コール度が3%

必ずホツピ一は用意  
やしたものを。泡が  
してください。泡が  
立つように熱いよ  
うにしてください。

# やっぱりホッピーが好き

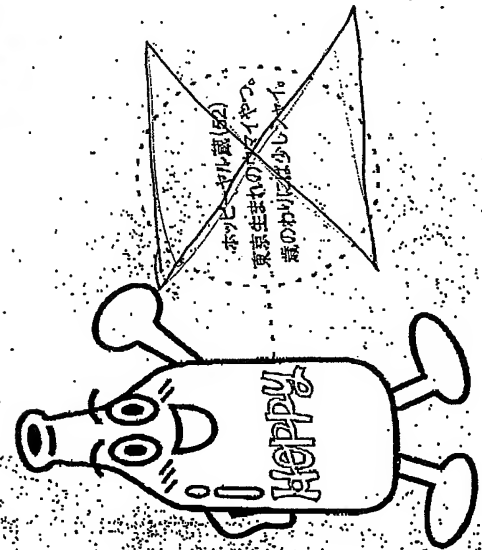
まいどー いやはや照れますね。でもうれしいうえ。こんちね、ホッピーヤル蔵です。ファンから「ホッピー飲んでー」ってんで名付けられたんえけど、今年でもう52なんスよ。フッフ、そんな歳にや見えないうでしよう。あつしは東京は赤坂生まれの赤坂育ち、ハリハリの江戸っ子なんス。

生まれたときからおいしさも、ルックスも、根強いファンも変わらな。相変わらずのホッピーヤル蔵なんです。幸せモンですよ、いまだにファンの愛、変わらずなんです。から、エヘ、コホン。

さて、ホッピーって名前、聞いたことがあってもまだ飲んだことのない人のために自己紹介しときますネ。

アルコール分はわずか0.8%なんです、それゆえにスツキリとした飲み心地、さらに健康的で低カロリーなんで、結構女性にもモテてんですよ。

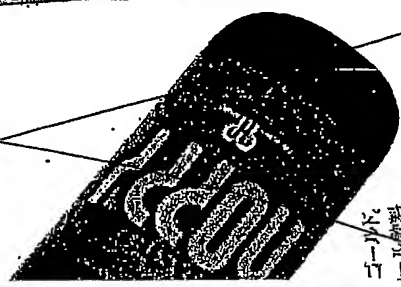
基本的にはビールと同じ造られ方をしているんですが、原料は厳選された三条大麦、コッパ、ン、ロン種、ドイツ、ハラタウ種。



アロマホップ、ドイツ、ワイエン、シエファン酵母銀行の酵母を漬床に使い、さらに天然水仕込みで作られた……まあ簡単にいうと最良の原料を使った「麦芽発酵飲料」なんです。

もちろん、スタンダードな飲み方は「焼酎割り」……ホッピーファンならご存じでしょうが、焼酎で割ったホッピーはほかの酒にはない、実にいい酔い心地になれるんスよね。誰が最初に始めたのか忘れたけれど、戦後間もないころはアルコール不足だったモンで、ホッピーに焼酎を入れて飲むとウマイという噂が広がったワケ。それが大ブームになって、今でもウマくてウマイってんで幅広く支持されてるんですよ。

## ホッピー瓶の変遷



ビール、アルコール飲料を製造する会社上がいます。

# ホップ工場見学

日本、いや世界でも唯一、ホッピーが生産されている釀造の工場へ行ってきました。当然、機械化はされているんだけど、手作りという雰囲気がいびつたりとハマる工場でした。



5  
きれいに洗浄された跳が  
続々とラインに登場して  
きました。これからホッ  
ーが仕入されるのです。  
こまごまのを見つめるとな  
か、ワクワクしてきますね。

3  
酒屋さんから回収した、  
リターナブル瓶の空瓶を  
洗浄します。煙草の吸い  
殻やゴミなどが入ってい  
ることが多いそうです。4  
槽に分けて丁寧に洗剤し  
ているので安心ですよ。

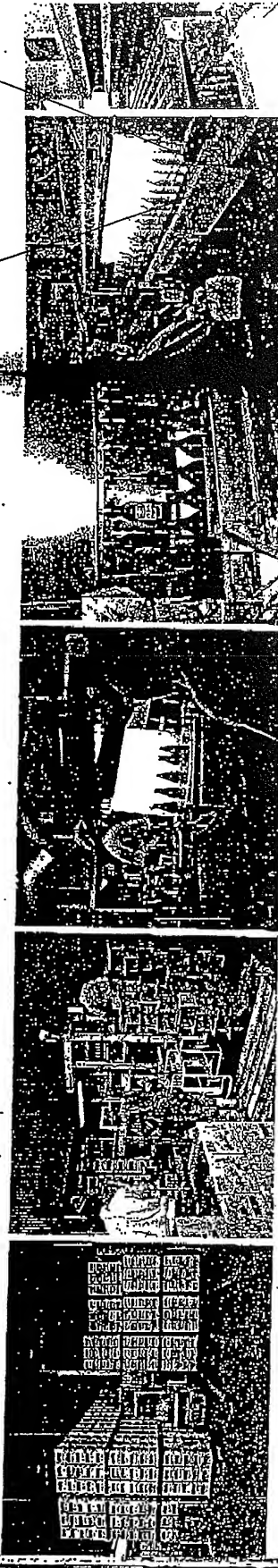
4  
洗浄した瓶がキッチンと洗  
剤で洗っているのが検査をして  
います。話しがけてはイ  
けません。取材中も職人  
のように(ゴメンナサイ)  
ばかりともしませんでし  
よ、ご苦労さまです。

2  
14日間、発酵させたホッ  
ピーをろ過します。この時  
点では普通のビールより  
アルコール度の少ないビ  
ールのような状態です。こ  
のあとに企業秘密の行程  
を経てホッピーになります。

1  
麦芽を糖化させる仕込み  
槽です。ホッピーを造る  
第一段階といえます。コ  
ーンスターチやホップと  
一緒に煮沸されたり冷却  
されたりするのです。大  
変です。



ホッピー工場見学



8

どうです、このホッピーの山。ここから、ホッピーのアンの特つ居酒屋や酒屋にホッピーが毎日、届けられるのです。

箱詰めしたホッピーをフオークリフトに乗せています。嫁を出す父親の心境とはこのことか？ ホッピーが本当に好きな人に飲まれろよ！ 米にはくれぐれも気をつけろよ！

7

6

ホッピーの入った瓶が流れてきました。瓶の中に不純物が入っていないか、ラベルがキチンと貼られているかの最後の確認をしています。

5

きれいに洗浄された瓶が、続々とラインに登場していきます。これからホッピーが注入されるのです。こういうのを見てるとたまに、ワグワグしてきますね。

4

洗浄した瓶がキチンと洗われているか検査をしています。話しかけてはいけません。屑材中も線入りのようば(ゴメンナサイ)ビクリともしませんでした。ご苦勞さまでです。

3

酒屋、リター、洗浄、殺菌、すること、槽に、入っている

5

(3) 微細濾過——多孔質のセラミック、あるいは微細な穴が開いたステンレスの薄板などを使用して、酵母を濾過、除未発酵、仕込みは開菌を完了する。瓶詰（缶詰）生ビール。

## 27 ビールの楽しみ方いろいろ——カクテルとビールの変わり種

ビールとカクテルの楽しみ方いろいろ

ビールのカクテルを飲もう

ビールのカクテル？ と不思議に思う人もいるかもしれませんが、世界にはいろいろなビールの飲み方があります。ここではビールのカクテルを楽しみましょう。

アルコールに弱い人のために勧めます。

〈ネバー・マインド〉——グラスにレモネードを半分入れ、その上からビールを静かに満たす。

恋人同士で二本のストローで仲良く飲むのはいいが、夢を語り、また、ディスコで踊るときに良いかも。

〈ヘッド・アイ〉——よく冷やしたトマトジュースをコップに半分をそぎ、次にビールで満たし、軽くステアして飲む。

〈シャンディ・ガフ〉——中型タンブラーにスクウト二〇ccをそぎ、ジンジャー・エールで満たして飲む。

ありきたりのビールに飽きた人には、異なったビールをミックスして自分にあつたビールをつくってみてはどうでしょう。

ベアフ・アンド・ベアフ — 中型タンブラーによく冷えたスタウトとビールを半々入れて飲む (スタウトと黒ビールでもよい)。

173

ビールでは物足りないという人は、ジンとミックスして飲みましょう。

ドッグス・ノーズ — 中型タンブラーに六〇ccのジンを入れ、よく冷えた黒ビールを満たして飲む。ジンは軽い品質のものが良いようだ。

水割りウイスキー、お湯割り焼酎ばかり飲むのではなく、ウイスキー、ジン、アクリビットや焼酎のストレートを、ビールをチェイサーにして飲むのがツウというものです。

〈ボイラー・メイカー〉 — ウイスキー・ストレートをビールをチェイサーにして飲むこと。

ビールの香りを少し変えてみましょう。別の世界が開けます。

エール・サンガー — 中型タンブラーに茶さじ半分の砂糖を入れ、少量のエールで溶かす。氷塊二丁三個を加えてよく冷えたエールを満たし、ナムメグ一つまみを振りかけて飲む (ビール、黒ビール、スタウトを用いてもよい)。

仕事で疲れた人は、ビールとともに良質のタンパク質をとり、疲れを癒しましょう。

〈エッグ・ビアー〉 — 大型タンブラーに卵黄一個と砂糖一さじを入れよく混合し、氷塊一二個を加えて、冷やしたビールを満たして飲む (卵黄の代わりに卵一殻を用いてもよい)。

シャンパンとビールをミックスして豪華に飲みましょう。シャンパンとビールのうまさ調和してとてもおいしくなります。

7/7

〈クラック・ベルベット〉 — 大型タンブラーによく冷やしたスタウトとシャンパンを半々に入れて飲む。これはヒスマルクともいう。よく冷やしたビールとシャンパン (ベルステッド・ストリート・ベルベットという)、ポーターとシャンパン (ベルベットという) でもよい。

ビール缶蓋の上に塩をのせ、ライム果汁を垂らして飲むメキシコの独特の飲み方や、コロンビアのレファファ (ベアフ飲料とビールを半々に混ぜたもの) やシホン (ソーダとビールを半々に混ぜたもの) という飲み方もあります。

#### ビールの変わり種いろいろ

世界には、まだ日本でもあまり知られていないビールがあります。飲んでみるとそれなりのおいしさがあり、その地方の風土や人々の暮らしがみえておもしろいものです。

ベルギーには、ブラッセル周辺のブリエーゲル地方のムギ (オオムギ六〇g、コムギ四〇g) とホップを原料として、野生酵母で発酵させ極端なゆっくりと熟成させてつくられるランビックと呼ばれる自然発酵ビールがあります。

このビールに同様にしてつくった一年もの、二年もの、三年ものビールを混ぜ、さらに熟成させ発酵性を強めたグーヌというビールがあります。酸味が強く、熟成した香味とホップの香りがよく調和して、こくがあるシャンパンのようなビールです。

この地方は果実が豊富です。このランビックに、果実を混ぜて熟成させたフルッツビールがあり



[p. 1]

## Hoppy College Magazine Course

### What is Hoppy?

It's a beverage that makes you happy (laughter). It has a long history that dates back to 1948, when it was first launched. Though initially sold as a non-alcohol beer, it ended up being drunk mixed with *shochu*. At a time when beer was still a luxury, Hoppy was loved as a beer substitute to be drunk with *shochu* by those who could not afford to buy beer. In other words, it was an inexpensive yet great friend of the ordinary people. It has a history longer than Lemon Sour, and can be regarded as the prototype of mixed drinks in Japan.

[p. 2]

### The Best Way to Enjoy Hoppy

Use the "Tripolar Cooling Method." Make sure you chill Hoppy, *shochu* and your mug in the refrigerator, and don't put any ice in your drink.

Here are the rules of etiquette you should observe to enjoy Hoppy. First pour *shochu* into the mug. Use the stars on the Hoppy Mug to adjust the level of alcohol in your drink. Twenty-five-proof *shochu* poured up to the lower star will give you an alcohol content of about 3%, and the upper star will give you one of about 8%. Enjoy your drink with the alcohol content of your choice.

Now, let me proceed to explain how to pour Hoppy into your mug. Pour Hoppy into the mug quickly to mix *shochu* and Hoppy together well. The quicker you pour, the more froth you get.

Once you get the knack, you'll find it easy to pour just the right amount of Hoppy from the bottle into your mug in accordance based on the amount of *shochu*. Don't stir your drink with a muddler or chopstick. Use type-A *shochu*, which is drier than type-B.

And that's the best way to enjoy Hoppy—although many bars serve it with ice as if that were the most natural way to serve Hoppy.

#### #1

These stars show you the level of alcohol. If you pour 25-proof *shochu* up to this star, you'll get an alcohol content of 8%.

#2

Twenty-five-proof *shochu* poured up to this star will give you an alcohol content of 3%.

#3

Make sure you serve Hopper cold. Pour it into your mug quickly to get maximum froth.

[p. 3].

I'm a Hoppy lover to this day.

Thanks a million! I feel a little shy, but I'm very pleased to hear it. Hello, my name is Hoppy the Drinker. My fans gave me this name, and I am already turning 52 years old this year. I look younger than my age, don't you think? I was born and bred in Akasaka, Tokyo, so I'm a native Tokyoite.

Ever since I was born, I've remained as good and handsome as now, with as many dedicated fans as I have today, and I've remained Hoppy the Drinker throughout these many years. Thanks to my many adoring fans, I am still living a happy life.

Well, some of you may have heard about Hoppy but may never have tasted it, so let me introduce myself.

I contain no more than 0.8% of alcohol and that's why I always taste fresh. I'm also low in calories and popular among women for that reason.

I'm brewed basically in the same way as beer: They make me from a selected variety of *Nijo* barley called "Golden Melon," aroma hops grown in Hallertau, Germany, and a copious amount of yeast obtained from the Weichenstephen Yeast Bank, and use natural water to brew me—in a word, I am a "malt-fermented beverage" made from the best quality materials.

Needless to say, the standard way to drink me is to mix me with *shochu*. As all Hoppy fans know, Hoppy mixed with *shochu* gives you a soothing feeling unrivalled by all other drinks. I don't remember who started it. Since alcohol was in short supply in Japan shortly after the end of World War II, it didn't take long before the word got around that Hoppy mixed with *shochu* was very good, and that's how the great Hoppy boom started. I continue to enjoy widespread popularity to this day because I remain as cheap and cheerful as ever.

[p. 4]

#### A Tour of a Hoppy Factory

I visited a factory in Chofu City—the only factory in Japan, or indeed the world, making Hoppy. Products are manufactured using automated machines, but the factory was full of the atmosphere of a handicraft workshop.

1. This is a reservoir tank where the malt is saccharified, which is the first stage in brewing Hoppy. The malt is mixed with cornstarch and hops, boiled together and chilled; all of which requires much work.
2. Fermented Hoppy is filtered for a period of 14 days. The product at this point is beer that contains less alcohol than ordinary beer. It is subsequently made into Hoppy through processes that remain confidential as business secrets.
3. Empty returnable bottles collected from liquor stores are being cleaned. I was told that these bottles often contain cigarette stubs and other trash. However, they are carefully washed through four stages until spotlessly clean.
4. The worker is checking whether the bottles have been thoroughly cleaned. You are not allowed to talk to him. He stood stock-still throughout my visit, hardly daring to breathe, like a wax doll (sorry). Don't work too hard!

[p. 5]

5. Bottle after bottle, all thoroughly washed and cleaned, come out in single file. These bottles are ready to be filled with Hoppy. I get excited to see such a scene.
6. Bottles filled with Hoppy are coming out. The final check is being carried out to make sure they contain no impurities and that the labels are properly attached.
7. Hoppy bottles, packed in boxes, are being transported by forklift. They bid farewell to the Hoppy bottles—just like fathers sending their daughters away for marriage. “Let them be drunk by Hoppy lovers! Watch out for ice!”
8. How do you like these mountains of Hoppy boxes? Hoppy bottles are delivered every day from here to bars and liquor stores, where Hoppy fans await.

[p. 6]

## 27 Many Ways to Enjoy Beer—Rare Varieties of Cocktails and Beers

Let's drink beer cocktails.

Beer cocktails? —Some of you may wonder what they are, but there are a wide variety of ways to enjoy beer. Let's enjoy some beer cocktails in this section.

Here are some cocktails recommended for those who can't drink too much alcohol.

<Never Mind>—Fill your glass half full with lemonade and pour beer slowly over the lemonade up to the rim. Share the drink with your girlfriend using two straws. Have a "Never Mind" and talk about your dreams or dance to disco music.

<Red Eye>—Fill your glass half full with cold tomato juice and fill it up with beer. Stir gently before drinking.

<Shandygaff>—Pour 120 cc of stout into a mid-sized tumbler and fill the rest of the tumbler with ginger ale.

If you are tired of ordinary beer, how about creating your own type of beer by mixing different beers?

[p. 7]

<Half and Half>—Fill a middle-sized tumbler half with cold stout and half with cold beer (or stout and black beer).

Beer not strong enough for you? Drink it with gin.

<Dog's Nose>—Pour 60 cc of gin into a mid-sized tumbler and fill it up with cold black beer. Gin with a mild flavor seems to go better with beer.

A lot of people drink whiskey with water and *shochu* with hot water, but beer connoisseurs know better—they drink whiskey, gin, aquavit or *shochu* straight and chase it with beer.

<Boiler Maker>—Drink whiskey straight, and then beer as a chaser. Try it with beers with different flavors—it makes a world of difference.

<Ale Sanger>—Put half a teaspoonful of sugar in a mid-sized tumbler and melt it with a small amount of ale. Add a couple of ice cubes, fill the tumbler with cold ale, and serve it with a pinch of nutmeg sprinkled on top (beer, black beer or stout may be used instead of ale).

Tired from overwork? Consume good quality protein together with beer and relax.

<Egg Beer>—Put an egg yolk and a spoonful of sugar into a large-sized tumbler, mix them well, add a couple of ice cubes, and fill the tumbler with cold beer (a whole egg may be used instead of a yolk).

Enjoy a luxurious mixture of champagne and beer. The flavors of champagne and beer harmonize with each other to produce an excellent taste.

<Black Velvet>—Fill a large-sized tumbler half with cold stout and half with champagne. It is also known as “Bismarck.” People often use cold beer (Halstead Street Velvet) or porter (Velvet) instead of stout.

In Mexico, people put salt and lime juice on top of a beer can and drink them together with beer. There are also cocktails popular in Columbia known as “Refajo” (beer mixed half and half with a herbal drink) and “Chiffon” (beer mixed half and half with soda).

